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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,089	11/03/2003	Erin Hall Sibley	PD-02-0421-B	9585
22462 7590 09/10/2007 GATES & COOPER LLP HOWARD HUGHES CENTER 6701 CENTER DRIVE WEST, SUITE 1050 LOS ANGELES, CA 90045			EXAMINER RABOVIANSKI, JIVKA A	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 09/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/700,089	SIBLEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jivka Rabovianski	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/12/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the Fig. 3 items 220 and 254 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims (1 –8, 9 -16) are rejected under 35 U.S.C. 102(e) as being anticipated by Croy et al; Clemens et al, US 6476825 B1 ("Croy" herein after).

The applied reference has a common different inventive with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Croy teaches:

A method for providing broadcast video programming ([0022] line 3-5 – “broadcast information as well as individual information may be supplied to the base station 100 and the PTVN hand-held device 200”), comprising:

receiving video programming (see abstract line 8-11 – “the hand-held remote device further including a display component for displaying at least a portion of the external information received from the data interface, the display component also for rendering video content in the video programming signals”;

encoding the video programming into a vertical blanking interval and unused Active lines of a television channel ([0004] line 16-18 – “Using conventional techniques, the data encoded in VBI can be extracted and provided to a microcontroller 130”);

and broadcasting the television channel and encoded video programming ([0020] line 1-3 – “a user of the

remote device 200 can scan through the available television channels (by channel increment/decrement or input of a channel number”; Fig.2/item 200).

Regarding claim 2, Croy teaches:

The method of claim 1, wherein the unused Active lines comprise Active lines that are hidden above and below typical lines that a viewer can see on a normal television screen. It is well known that the vertical blanking interval is the time interval between the end of the last line of one frame or field of a raster display, and the beginning of the next. During the VBI the incoming data stream is not displayed on the screen (unused Active lines). In analog television systems the vertical blanking interval

can be used to carry digital data, since nothing sent during the VBI is displayed on the screen.

Regarding claim 3, Croy teaches:

The method of claim 1, wherein the encoded video programming is completely transparent to the television channel that is broadcast ([0004] line- 15-18 –“ VBI decoder 122, coupled to tuner 120, receives a data stream in the vertical blanking interval (VBI) of a particular predetermined channel. Using conventional techniques, the data encoded in VBI can be extracted and provided to a microcontroller 130”, Fig. 1/ 120,122).

Regarding claim 4, Croy teaches:

The method of claim 1, wherein the encoded video programming comprises a premium cable channel ([0004] line 3-4 –“ The base station 100 receives external information from a cable television provider 110” fig. 1/100,110).

Regarding claim 5, Croy teaches:

The method of claim 1, further comprising receiving the broadcast encoded video programming in a wireless device ([0093] line 1-4 – “The Personal TV system 5500 can also act as a cordless telephone. To achieve that function, conventional cellular or satellite circuitry for wireless telephone communications is installed in the base unit 5512 and/or the hand-held remote device 5514.” Fig. 56 / 5514).

Regarding claim 6, Croy teaches:

The method of claim 5, wherein the wireless device comprises a receiver card for receiving the broadcast encoded video programming ([0006] line 9-10 – “remote

interface 138 may be a direct coupling connection between base station 100 and remote device 200" see Fig. 2/200 – remote device [0006] line 4-5 – "Remote interface 138 may be a conventional infrared (IR) link with a corresponding interface transmitter/receiver 210 within remote device 200" [0009] line 6-8 – "Data received by remote device 200 via base station interface 210 is fed to microcomputer 220 within remote device 200").

Regarding claim 7, Croy teaches:

The method of claim 1, further comprising receiving the broadcast video programming in a user device, wherein the user device comprises:

(a) tuning hardware configured to receive normal over-the-air broadcasts and to pass the encoded video programming ([0004] line 12-13 – "Tuner 120 separates out the various channels received from cable provider 110" Fig. 1/ 120;

(b) vertical blanking interval software configured to ([0004] line 15 – "VBI decoder 122, coupled to tuner 120" Fig. 1/122):

(i) receive output from the tuning hardware([0004] line 15-16 – "receives a data stream in the vertical blanking interval (VBI) of a particular predetermined channel"; and

(ii) decode the encoded video programming ([0004] line 19-20 – " for decoding data from the overscan portion or a separate carrier on the predetermined channel");

(c) decompression software configured to:

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(i) decompress the decoded video programming ([0004] line 21 –“ Microcontroller 130 decodes the information, descrambles it”); and

(ii) output analog audio and video signals to a screen and speaker of the user device ([0032] line 4-5 –“ download over broadcasting networks: TV analog/digital; terrestrial, cable, satellite; VBI, dedicated channel”).

Regarding claim 8, Croy teaches:

The method of claim 7, wherein the vertical blanking interval software further comprises subscriber management, conditional access, and encryption functions to control access to the video programming in the vertical blanking interval and unused Active lines ([0004] line 21-22 –“ Microcontroller 130 decodes the information, descrambles it (if necessary) and looks for service and control information in the VBI information” It will cause the base station Fig.1/100 to send data or not (conditional access).

Per claim 9 see the analysis of claim 7. The claim limitation was analyzed with respect to claim 7.

Per claim 10 see the analysis of claim 2. The claim limitation was analyzed with respect to claim 2.

Per claim 11 see the analysis of claim 3. The claim limitation was analyzed with respect to claim 3.

Per claim 12 see the analysis of claim 4. The claim limitation was analyzed with respect to claim 4.

Per claim 13 see the analysis of claim 5. The claim limitation was analyzed with respect to claim 5.

Per claim 14 see the analysis of claim 6. The claim limitation was analyzed with respect to claim 6.

Claims 15 cover the same steps as claim 1 using "software". As Croy teaches, "the PTVN 200 and base 100 hardware normally comes fully equipped with the software and firmware needed for an application." which does the same function as above claim

1. See MPEP 2144 Rationale for Obviousness

Per claim 16 see the analysis of claim 8. The claim limitation was analyzed with respect to claim 8.

***Examiner's Note***

3. The referenced citations made in the rejection(s) above are intended to exemplify areas in the prior art document(s) in which the examiner believed are the most relevant to the claimed subject matter. However, it is incumbent upon the applicant to analyze the prior art document(s) in its/their entirety since other areas of the document(s) may be relied upon at a later time to substantiate examiner's rationale of record. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). However, "the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does

not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

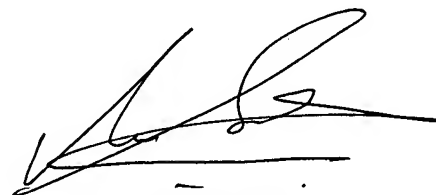
### **Contact**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jivka Rabovianski whose telephone number is (571) 270-1845. The examiner can normally be reached on M-F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SRIVASTAVA VIVEK can be reached on (571) 272-7304. Customer Service can be reached at (571) 272-2600. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jivka Rabovianski/



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